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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,805	07/23/1999	CHARLES E. CLUM	JBP-462	4667

7590 11/25/2002

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EXAMINER

HARTLEY, MICHAEL G

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/360,805

Applicant(s)

CLUM ET AL.

Examiner

Michael G. Hartley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 64-145 is/are pending in the application.
- 4a) Of the above claim(s) 64-145 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-15 and 64-145 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Continued Prosecution Application

The request filed on 04/23/2001 (as marked on the postcard receipt) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/360,805 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

The amendment filed 4/23/2001 (as marked on the postcard receipt, to which a faxed copy thereof was requested by the office and received 10/24/2002) has been entered. Claims 16-63 have been canceled. New claims 64-145 have been added. Consequently, claims 1-15 and 64-145 are pending herein.

The following is noted herein:

1) The serial number on the correspondence of 4/23/2001 was incorrect as it listed "08/360,805" as opposed to the correct serial number of the 09 series application, "09/360,805."

2) The amendment to add claims 64-145 was not in accordance with 37 CFR 1.173 that requires all matter to be added by reissue to be underlined. New claims 64-145 were not underlined in the amendment filed 4/23/2002. See 37 CFR 1.173(d).

3) The present reissue application is a CPA, which was filed after November 7, 2000 and therefore is subject to the making of a restriction requirement in accordance with 37 CFR 1.176.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a skin care composition comprising a water-in-oil emulsion and a retinoid and a stabilizing system comprising a chelating agent and at least one water-soluble antioxidant, classified in class 514, subclass 529.
- II. Claims 64-145, drawn to a method of manufacturing an emulsion skin care composition comprising a retinoid and any one of three stabilizing systems, classified in class 424, subclass 455.

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The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make a materially different product. For example, the process as claimed can be used to make oil-in-water emulsions, which are different from the water-in-oil emulsions of the product. Also, the process as claimed can be used to make emulsions which do not include a stabilizer comprising a chelating agent and at least one water soluble antioxidant as required by the product, (e.g., stabilizers "ii" and "iii" do not have a stabilizing system as set forth in the product of Group I).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Election (Constructive)

The Group I invention has been constructively elected for prosecution on the merits in accordance with 37 CFR 1.176. Newly submitted claims 64-145 are directed to an invention that is independent or distinct from the invention constructively elected for the following reasons set forth above. Accordingly, claims 64-145 are withdrawn from consideration as being directed to a non-elected invention.

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Allowable Subject Matter

Claims 1-15 are allowed. Claims 1-15 are free of the art of record and are allowed herein. The primary reason for allowance is the inclusion of specific stabilizing system as set forth in claim 1, which comprises a chelating agent and a water soluble antioxidant in a water-in-oil emulsion containing a retinoid as claimed. The closest prior art, Awamura and Yasushige (of record) fail to teach or suggest the use of such a stabilizing system (i.e., the combination of a chelating agent and a water soluble antioxidant) in a water-in-oil emulsion containing a retinoid, as claimed.

This application is in condition for allowance except for the presence of claims 64-145 to a non-elected invention and the prosecution of this case is closed except for consideration of this matter.

NOTE: Applicant is advised that due to the constructive election of claims 1-15, claims 64-145 will not be considered in this application and will be considered only if filed in a divisional reissue application. Should a divisional reissue application be filed the prosecution of this application will be suspended until such time as the divisional application is allowed or abandoned. At that time appropriate action will be taken in this application. If no divisional reissue application is filed cancellation of claims 64-145 will result in this application becoming a "no-defect reissue" application, unless other substantive errors are found and corrected, and will be held abandoned.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Hartley whose telephone number is (703) 308-4411. The examiner can normally be reached on M-F, 7:30-5, off alternative Mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose G. Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

MH
November 22, 2002


MICHAEL G. HARTLEY
PRIMARY EXAMINER